REMARKS

Claims 1-33 are currently pending in the subject application and are presently under consideration. Claims 1, 20, 24, 28, and 29 have been amended as shown at pages 2-7. Favorable reconsideration of the subject patent application is requested in view of the comments and amendments herein.

I.   Rejection of Claims 1-8, 11-19, and 29-33 Under 35 U.S.C. §101

Claims 1-8, 11-19, and 29-33 stand rejected under 35 U.S.C. §101 as not being tangible since the elements or features of the claimed Machine can be implemented by software alone. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Independent claims 1 and 29 have been amended herein to overcome the subject rejection by further emphasizing the useful, concrete and tangible results produced. Accordingly, withdrawal of this rejection with respect to independent claims 1 and 29 (and associated dependent claims) is respectfully requested.

> Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 *citing In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (Emphasis added) (holding that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display).

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As recited in the claims, a useful, concrete, and tangible result is produced. More particularly, as recited in amended independent claim 1, an asset component defines one or more factory assets, an access component defines one or more security attributes associated with the factory assets, and a security component *regulates access to the factor assets based upon* the one or more security attributes. Moreover, as recited in independent claim 29 as amended, data fields describe factory assets and security parameters, and a schema associates the data fields to *limit access* to the factory assets based upon the security parameters. Thus, a number of useful, concrete, and tangible results are produced: namely, access to defined factory assets is regulated according to further defined security attributes.

In view of the above, it is readily apparent that the claimed invention produces a useful, concrete, tangible result and is limited to practical applications in the technical arts; therefore, pursuant to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed.Cir. 1999), the subject claims are directed to statutory subject matter pursuant to 35 U.S.C. §101. Accordingly, this rejection should be withdrawn.

However, even if claims 1 and 29 are evaluated as pertaining to software code as the Examiner asserts, rejection under 35 U.S.C. §101 of these particular claims is erroneous in view of the recent Federal Circuit opinion in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005), wherein the court stated:

> Title 35, section 101, explains that an invention includes 'any new and useful process, machine, manufacture or composition of matter.' Without question, *software code alone* qualifies as an invention eligible for patenting under these categories, at least as processes. (emphasis added) (citations omitted).

Claims 1 and 29, if viewed as pertaining to software code, undeniably fall within the bounds of this holding. Therefore, in view of at least the foregoing, rejection of these particular claims (and associated dependent claims) under 35 U.S.C. §101 is preemptive, and thus, should be withdrawn.

II.   Rejection of Claims 24-27 Under 35 U.S.C. §101

Claims 24-27 stand rejected under 35 U.S.C. §101 as not being tangible since the steps of the method do not require use of hardware or computer system to accomplish the steps. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Independent claim 24 has been amended herein to overcome the rejection by further encompassing programmatic and automated elements of the proposed method such to remove any prospect of human ability. Practical application of claim 24 as amended would produce a tangible result as required under 35 U.S.C. §101, and accordingly, withdrawal of this rejection (and rejection to associated dependent claims) is respectfully requested.

III.   Rejection of Claims 1-7 and 11-33 Under 35 U.S.C. §102(e)

Claims 1-7 and 11-33 stand rejected under 35 U.S.C. §102(e) as being anticipated by Brown (US 6,571,141). It is respectfully requested that this rejection should be withdrawn for at least the following reasons. Brown does not disclose each and every element of the subject claims.

> For a prior art reference to anticipate, 35 U.S.C. §102 requires that "*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

Claims 1, 24, and 29

The claimed invention relates to an automated system to facilitate network security in an industrial automation environment. To that end, independent claim 1 recites an automation security system comprising an asset component that defines one or more factory assets, and similarly, independent claim 29 recites a data field that describes factory assets. Additionally, claim 24 as amended recites electronically analyzing one or more automation assets. Brown fails to disclose such aspects of the applicants' claimed invention.

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Brown discloses a system to facilitate secure application development for a plurality of motion control systems attached to a personal computer. The system employs API access blocking to prevent the program administrator/software developer from utilizing certain software API functions of the attached motion control system, as well as, API parameter limit blocks to regulate values used when calling certain software API functions such to protect the motion control system from operating in a manner that is unsafe. Brown discloses prior art motion control systems and the generation of software for such systems usually "involves the labors of at least two and perhaps three separate designers: a software system designer; a hardware system designer familiar with the intricacies of the motion control device; and a *motion control system designer*." (*See*, col. 4, ll. 40-46). (Emphasis added).

In the Office Action dated December 15, 2005, the Examiner incorrectly asserts that Brown teaches all claimed aspects, and provides specific examples to support such assertion. More particularly, the Examiner asserts that a *motion control system designer* defining an overall motion control system is indicative of Brown disclosing an *asset component* to define one or more factory assets or a first *data field* that describes factory assets as in the subject claims. However, it would be apparent to one ordinarily skilled in the art that *components* and *data fields* relate to systems performing certain tasks and not to human entities, as a *motion control system designer*, doing such. Additionally, claim 24 as amended recites an electronic methodologies which likewise lack the human characteristics of a *motion control system designer*. In view of at least the foregoing, Brown does not disclose asset components or data fields that respectively define or describe factory assets, nor does it recite a method for electronically analyzing one or more automation assets as in the subject claims. Therefore, rejection of independent claims 1, 24, and 29 (as well as claims 2-7, 11-19, 25-27, and 30-33 which respectively depend therefrom) under 35 U.S.C. §102(e) should be withdrawn.

Claim 20

As amended, claim 20 recites one or more servers that manage a network interface between networked factory assets and *other devices* attempting access to the networked factory assets. Brown fails to disclose each and every element of the recited

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claim. As mentioned above, Brown discloses a system that implements a security procedure for developing software applications on a computer that can implement a set of functions for a connected motion control system. Such security is deployed in the aforementioned two methods of API blocking and API parameter limiting, such that the system is aimed at controlling a *software system designer's* access to *author software* for motion control systems directly connected to the computer by removing or limiting the ability to utilize certain API calls. This does not disclose a server that manages a network interface between networked factory assets and *other devices* attempting to access the factory assets. In view of the foregoing, Brown fails to disclose the applicants' invention as claimed, and rejection of independent claim 20 (as well as claims 21-23 which depend therefrom) under 35 U.S.C. §102(e) should be withdrawn.

Claim 28

Claim 28, as amended, recites a means for automatically determining which network devices require security resources. Brown fails to disclose such claimed aspects. In particular, Brown discloses a *"program administrator* to control the operation of the software system such that access to one or more API functions is restricted based on..." (*See*, col. 6, ll. 57-65). Similar to the deficiencies in claims 1, 24, and 29, Brown discloses a human element in controlling the security whereas the subject claims recite a system capable of automatically determining where security resources are to be deployed. In view of the foregoing, Brown does not teach such claimed aspects, and thus, rejection of independent claim 28 under 35 U.S.C. §102(e) should be withdrawn.

IV. Rejection of Claim 8 Under 35 U.S.C. §103(a)

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Brown as Brown does not teach an ISA S95 Model for Enterprise to Control System integration, however, such is well known and expected in the art. It is respectfully submitted that this rejection should be withdrawn for the following reasons. Claim 8 depends upon independent claim 1, and thus, even if ISA S95 Model for Enterprise to Control System integration is well known and expected in the art, it does not make up for

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the aforementioned deficiencies of Brown with respect to claim 1. Accordingly, it is respectfully submitted that this rejection should be withdrawn.

IV.   Rejection of Claims 9-10 Under 35 U.S.C. §103(a)

Claims 9-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brown in view of Blumenstock (US 2002/0006790). It is respectfully submitted that this rejection should be withdrawn for the following reasons. Blumenstock discloses a system for invoking remote activity on an automation system *via* sending an email message to a device that has access to the automation system. A firewall is provided in accordance with the internal network on which the receiving device and the automation system reside. Blumenstock does not disclose a system with the ability to *specify parameters to assemble and configure* the generic IT components (such as a firewall) as stated in the subject claims. Additionally, claims 9-10 depend upon independent claim 1, and Blumenstock does not make up for the aforementioned deficiencies of Brown with respect to claim 1. Accordingly, it is respectfully submitted that this rejection should be withdrawn.

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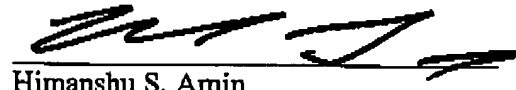
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[ALBRP303USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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